

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

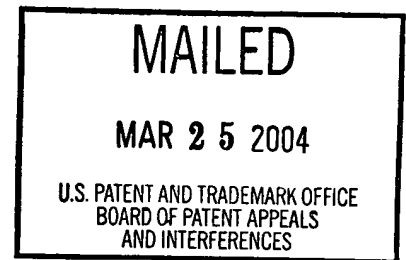
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MAXIE A. DUREL-CRAIN

Appeal No. 2004-0563
Application No. 09/975,747

ON BRIEF



Before FRANKFORT, McQUADE and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20 and 22. Claims 1 through 7, 13 through 19, 21, 24, 25 and 27 through 29 have been canceled. Claims 8 through 12, 23 and 26 stand allowed.

Appellant's invention relates generally to feminine hygienic tampons having strings attached thereto for withdrawal. More particularly, the invention on appeal is directed to such a tampon having a string attached at a first end to the tampon and having a length of 9 inches to 13 inches. Page 2 of the specification (lines 20-21) indicates that the apparatus of the present invention is a tampon with means for

preventing the tampon string from completely retreating into a user's vagina. On page 3, it is also noted that the longer than customary string on appellant's tampon makes it easier for a woman to locate the free end of the string.

Claims 20 and 22 on appeal read as follows:

20. Apparatus comprising:

a tampon;

a tampon string attached to the tampon, the tampon string having a first end attached to a tampon and a second, free end distal from the tampon, the tampon string having a length of 9" to 13".

22. The apparatus of claim 20, wherein the tampon string has a length of 11" to 12.5" (27.9-31.8 cm).

The sole prior art reference of record relied upon by the examiner as evidence of obviousness of the claimed subject matter is:

Yeo

5,533,990

Jul. 9, 1996

Claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yeo.

Reference is made to the examiner's answer (Paper No. 12, mailed April 23, 2003) for the reasoning in support of the above-noted obviousness rejection and to appellant's brief (Paper No. 11, filed April 1, 2003) for appellant's arguments thereagainst.

OPINION

In arriving at our decision on the obviousness issue raised in this appeal, we have given careful consideration to appellant's specification and claims, the teachings of the applied prior art Yeo reference, and the respective positions advanced by appellant and the examiner. Upon evaluation of all of the evidence before us, it is our conclusion that the examiner's above-noted rejection under 35 U.S.C. § 103(a) will be sustained. Our reasoning for this determination follows.

In rejecting claims 20 and 22 as being obvious to one of ordinary skill in the art at the time of appellant's invention, the examiner has determined that Yeo discloses a tampon "substantially as claimed," except that Yeo does not disclose a withdrawal string having a length in the claimed range of 9-13 inches. In that regard, the examiner notes that Yeo discloses a withdrawal string (16) which is said to "normally" have a length extending beyond one end of the tampon (10) of "from about 2 inches to about 8 inches (about 50.8 mm to about 203.2 mm)" (col. 4, lines 8-11). To account for the difference between the teachings of Yeo and the tampon apparatus claimed by appellant, the examiner urges that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to make the string of Yeo 9 inches in length or even 11 inches in length to provide more string for the user to grasp and manipulate during removal of the tampon. In the event the tampon is

inserted further up the vaginal canal than intended, this would ensure that enough string remained outside the body to allow the user to effectively grasp to remove the tampon (examiner's answer, page 3).

Appellant's argument addressing the examiner's rejection of claims 20 and 22 is found on page 3 of the brief and reads as follows:

Applicant notes that the Examiner has suggested why one of ordinary skill in the art might have found it obvious to extend the length of the string of Yeo. However, this is mere conjecture on the part of the Examiner and there is nothing in the prior art of record to suggest such a modification. It is respectfully submitted that merely because one can, in hindsight, suggest a reason why someone might have wished to modify an earlier reference does not mean that it would have been obvious at the time the invention was made to make the invention as claimed. Claim 20 is respectfully submitted to be patentable as there is no suggestion for modifying Yeo as suggested by the Examiner, other than in the present application.

Like the examiner, we observe that Yeo discloses a tampon (10) having a withdrawal string (16) which is secured to the tampon, and that the patentee notes in column 3, lines 1-6, that the withdrawal string provides a safe and reliable means by which the tampon (10) can be withdrawn from a woman's vagina after it has absorbed a certain amount of menstrual fluid. While Yeo discloses that the withdrawal string (16) extends beyond one end of the tampon and sets forth that the string "normally" has a length in the range of between about 2 and about 8 inches, we must agree with the examiner that it would have been obvious to one of ordinary skill in the art at the

time of appellant's invention to lengthen the withdrawal string of Yeo to a length within the claimed range so as to provide the self-evident advantage of more withdrawal string for the user to grasp and manipulate during removal of the tampon, especially in the event the tampon may be inserted or migrate further up the vaginal canal than normal or intended.

While we can agree with appellant that there is nothing in Yeo to specifically or expressly suggest a modification in the length of the withdrawal string therein of the nature urged by the examiner, we point out that there are three possible sources for motivation to combine or modify references: 1) the nature of the problem to be solved, 2) the teachings of the prior art, and 3) the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

In this case, it appears the examiner has relied upon all three of these sources to support the rejection before us on appeal. In that regard, we note that Yeo only states that the withdrawal string "normally" has a length in the range of about 2 to about 8 inches, thereby, in our view, impliedly suggesting that other lengths may be used when appropriate. As for the nature of the problem to be solved and the knowledge of persons of ordinary skill in the art, we point to the discussion of the problem to be solved set forth on page 1 of appellant's specification. More particularly, we observe that appellant indicates that it is a well known problem that due to frictional migration

and the expansion and contraction of the vagina, especially during physical activity, the tampon can get lodged near the back of the vagina or rotated in such a manner that the string is withdrawn into the vagina cavity. In fact, appellant characterizes this as a serious problem affecting "thousands of women nationally each year" and requiring a visit to a gynecologist to retrieve the lost tampon.

Looking at the totality of the circumstances, it is our opinion that the claimed subject matter as a whole set forth in claims 20 and 22 on appeal would have been obvious at the time the invention was made to a person having ordinary skill in the art, and that the nature of the problem to be solved essentially provides its own suggestion to the knowledgeable artisan as to how to solve the problem, i.e., by providing extra length for the tampon withdrawal string.

As the examiner has observed on page 4 of the answer, aside from urging that Yeo itself does not specifically teach or suggest the length modification, appellant has not otherwise addressed the examiner's stated position and reasoning laying out why one of ordinary skill in the art would have been motivated to make the withdrawal string of Yeo's tampon longer and of a length within the claimed range.

In light of the foregoing, we will sustain the examiner's rejection of claims 20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Yeo.

In addition, we make note of U.S. Patent No. 5,807,372 to Tammy Jo Balzar, cited by appellant on page 2 of the specification. During any further prosecution of this application, the examiner should consider whether this patent anticipates or would have rendered appellant's claimed tampon obvious within the meaning of 35 U.S.C. § 103. We particularly direct attention to the embodiments seen in Figures 6, 7, 14 and 16 of this patent, noting that the softwind (22) can have a length (L_2) of up to 10 inches (col. 5, lines 46-47), and the disclosure in column 7, lines 3-6, that the withdrawal string should have a length which "extends outwardly from the softwind 22 a distance of from between about 2 inches to about 8 inches," thereby apparently putting the overall length of the withdrawal string of Balzar's tampon from the tampon cleft (42) to the free ends thereof within appellant's claimed range of 9-13 inches.


The decision of the examiner rejecting claims 20 and 22 of the present application is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS
) AND
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